REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed February 2, 2005. At the time of the Final Office Action, Claims 1-22 were pending in this Application. Claims 1-6, 8, 9, 11-17 and 19-22 were rejected. Claims 7, 10 and 18 were objected to. Claims 20-22 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-5, 9 and 12-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 4,608,506 issued to Chiaki Tanuma ("Tanuma") in view of U.S. Patent 4,632,311 issued to Shinichi Nakane et al. ("Nakane et al."). Applicants respectfully traverse and submit that the combination of the teachings of Tanuma and Nakane, even if proper which Applicants do not concede, does not render the claimed invention obvious.

Claims 6, 8, 11, 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tanuma in view of Nakane et al., and further in view of U.S. Patent 5,387,834 issued to Masashi Suzuki ("Suzuki"). Applicants respectfully traverse and submit that the combination of the cited art, even if proper which the Applicants do not concede, does not render the claimed invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to §2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Examiner states "Applicant [sic] marks [sic] an interesting point regarding Nakane fig. 12 and the presence of inductor #21. However, the inductor 321[?] is also used in the fig. 13 circuit which teaches an alternate wherein compensation capacitor #42 is connected in series. Thus, inductor 321[?] is a constant, not in both parallel and series alternatives and thus not unique or essential to only the parallel version. Indeed, for both series and parallel connections, the capacitive value of the inductor #21 must be low. Nothing would be lower than elimination of the inductor. (see Nakane, Col. 8, lines 30-59[?])"

Applicants respectfully request clarification of the rejection and removal of the finality of the rejection. First, a review of Nakane, et al. reveals they do not disclose an "inductor 321." Thus, Applicants find it difficult to respond. In addition, the Examiner cites "Nakane Col. 8, lines 30-59" as supporting his rejection; however, Nakane et al do not have a Column 8, Nakane ends at Column 6, line 67. Consequently, again, Applicants are unable to respond. Finally, it is noted that the Examiner seems to argue that while an "inductor" is included in Nakane's Figures 12 and 13, one could just eliminate Nakane's inductor. ("Nothing would be lower than elimination of the inductor. (see Nakane Col. 8, lines 30-59.)" As noted, Nakane does not teach such an elimination. And Nakane, et al. certainly do not teach the elimination of an "inductor" at "Col. 8, lines 30-59" which does not even exist in Nakane. Withdrawal of the rejection is respectfully requested. Further, in light of the errors in the rejection, Applicants requests withdrawal of the finality of the action.

Rejections under 35 U.S.C. §112

Claims 20-22 were rejected by the Examiner under 35 U.S.C. §112, first paragraph. Applicants amend Claims 20-22 to overcome these rejections and respectfully request full allowance of Claims 20-22 as amended.

Allowable Subject Matter

Applicants appreciate Examiner's consideration and indication that Claims 7, 10, and 18 would be allowable if rewritten in independent form to include all of the limitations of the

base claim and any intervening claims. Applicants amend Claims 20-22 to include all the limitations of Claims 7, 10, and 18 and the limitations of the base claims and any intervening claims. Applicants submit Claims 20-22, indicated as allowable, are now in condition for allowance.

Information Disclosure Statement

Applicants enclose a new Information Disclosure Statement and PTO Form 1449, along with a check in the amount of $180.00, for the Examiner's review and consideration.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no additional fees due, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,
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Date: April 4, 2005

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